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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 99,139-G)

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|---|---|---|
| **In the Application of:** | **Kolb et al.** | |
| **Serial No.:** | **10/797,458** | **Examiner: P. Zucker** |
| **Filing Date:** | **March 10, 2004** | **Group Art Unit: 1621** |
| **For:** | **Novel PPAR-γ Agonists as Agents for the Treatment of Type II Diabetes** | |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## TRANSMITTAL LETTER

In regard to the above-identified patent application:

1. We are transmitting herewith the attached:
   a. Response to the Office Action mailed November 2, 2004
   b. Postcard

2. Please charge any additional fees or credit over-payments to the Deposit Account No.13-2490.

4. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this Transmittal Letter and the paper(s), as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA on this 3rd day of January, 2005.

Dated: January 3, 2005

By: Stephen H. Docter
Stephen H. Docter
Reg. No. 44,659

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300 South Wacker Drive
Chicago, Illinois 60606
Tel: (312)913-0001

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**(Case No. 99,139-G)**

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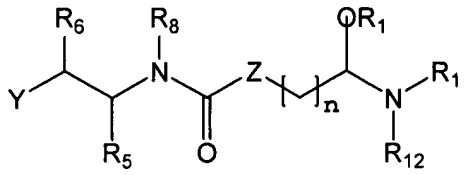
**RESPONSE TO THE OFFICE ACTION MAILED NOVEMBER 2, 2004**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Office Action Mailed November 2, 2004 in the above-mentioned case, Applicants can not elect a species as set forth in present claim 3, as all compounds therein are the subject matter of issued claims found in the parent case, U.S. Patent No. 6,713,514, issued from U.S.S.N. 09/552,477. As a result, Applicants herewith propose and election of invention within the subject matter of claim 1 as follows.

A compound of the formula




or the pharmaceutically acceptable non-toxic salts thereof wherein:

Z is a 5 or 6 membered aryl or heteroaryl ring optionally substituted with up to three groups selected from lower alkyl, halogen or lower alkoxy;

n is 1 or 2;

$R_1$ and $R_{12}$ are the same or different and represent hydrogen, lower alkyl, $SO_2(R_{10})$, or

cycloalkyl optionally substituted with one, two, three or four groups independently selected from halogen, trifluoromethyl, trifluoromethoxy, cyano, nitro, carboxyl, alkoxycarboxy, alkylcarboxy, hydroxy, lower alkyl, lower alkoxy, amino, or mono or dialkylamino where each alkyl portion is lower alkyl, or

aryl, heteroaryl, arylalkyl, or heteroarylalkyl, where the ring portion of each is optionally substituted with one, two, three or four groups independently selected from halogen, trifluoromethyl, trifluoromethoxy, cyano, nitro, carboxyl, alkoxycarboxy, alkylcarboxy, hydroxy, lower alkyl, lower alkoxy, amino, or mono or dialkylamino where each alkyl portion is lower alkyl;

$R_{10}$ is hydrogen or lower alkyl, or aryl, heteroaryl, arylalkyl or heteroarylalkyl, where the ring portion of each is optionally substituted with one, two or three groups independently selected from halogen, trifluoromethyl, trifluoromethoxy, cyano, nitro, carboxyl, alkoxycarboxy, alkylcarboxy, hydroxy, lower alkyl, lower alkoxy, amino, or mono or dialkylamino where each alkyl portion is lower alkyl;

$R_9$ is H or lower alkyl;

Y is hydrogen, $NR_1R_{12}$, $OR_1$, $CH_2R_1$, $SR_1$, $SOR_1$ or $SO_2R_1$; and

$R_5$, $R_6$ and $R_8$, are the same or different and represent hydrogen, lower alkyl, $R_{10}C{=}O$, $R_{10}SO_2$, or

cycloalkyl optionally substituted with one, two, three or four groups independently selected from halogen, trifluoromethyl, trifluoromethoxy, cyano, nitro, carboxyl, alkoxycarboxy, alkylcarboxy, hydroxy, lower alkyl, lower alkoxy, amino, or mono or dialkylamino where each alkyl portion is lower alkyl, or

aryl, heteroaryl, arylalkyl, or heteroarylalkyl, where the ring portion of each is optionally substituted with one, two, three or four groups independently selected from halogen, trifluoromethyl, trifluoromethoxy, cyano, nitro, carboxyl, alkoxycarboxy, alkylcarboxy, hydroxy, lower alkyl, lower alkoxy, amino, or mono or dialkylamino where each alkyl portion is lower alkyl; or

$R_5$ and $R_6$ together with the carbon atom to which they are attached form a 5, 6, or 7 membered carbocyclic ring up to two of which members are optionally hetero atoms selected from oxygen, sulfur and nitrogen.

Allowance of the claims and passage of the case to issue are respectfully solicited. The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-0001 if the Examiner believes that this would expedite prosecution of this application.

Respectfully submitted,

By: _____

Dated: January 3, 2005

Stephen H. Docter
Reg. No. 44,659

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